REMARKS

In the Office Action dated February 12, 2007, the Examiner made a number of general statements regarding the necessity of including a designation of a prior application in the specification of the present application. None of the sections of 35 U.S.C. or 37 C.F.R. cited by the Examiner are applicable to the present application, however, since the Examiner has incorrectly over-generalized several of these citations, Applicants are constrained to respond to those inaccuracies in order to avoid any prejudice to the present Applicants.

The Examiner stated that if Applicants desire to claim the benefit of a prior-filed application under 35 U.S.C. §119(a-d), a specific reference to the prior-filed application must be included in the first sentence of the present specification, in compliance with 37 C.F.R.§ 1.78(a).

It is true that Applicants are claiming the benefit of convention priority under 35 U.S.C. §119(a), based on a prior application filed in Germany. 37 C.F.R.§1.78(a), however, is not applicable to a claim of convention priority under 35 U.S.C. §119(a), and there is no mention of 35 U.S.C. §119(a) anywhere in 37 C.F.R.§ 1.78(a). 37 C.F.R.§1.78(a) is applicable only in the case of conversion of a provisional application into a non-provisional application, or in the case of claiming the benefit of the filing date of an earlier-filed United States application (such as in the case of a subsequently filed divisional or continuation application), or in the case of an International application designating the United States. None of those situations is applicable to the present application, and therefore no amendment of the specification herein is necessary. Hundreds of thousands of patents issue every year in the United States that claim the benefit of convention priority based on an

earlier-filed foreign application, and none of those issued patents includes a statement in the specification regarding the claim for convention priority, and therefore clearly such a statement is not required by 37 C.F.R.§1.78(a), or any other rule or statute.

Claims 1-4, 17 and 18 were rejected under 35 U.S.C. §102(b) as being anticipated by Aldefeld et al. Claims 1-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Aldefeld et al. in view of Hastings et al.

In the subject matter disclosed in the present application, an x-ray image of an examination subject is obtained in order to permit monitoring of the movement of an OCT catheter in the subject, while OCT images are being obtained. In the language of original claim 1, it was only stated that the x-ray image and the OCT image are both presented at a monitor. Claim 1 has been amended to make clear that the x-ray image is generated *after* the introduction of the OCT catheter into the subject, and that the x-ray image and the OCT image are simultaneously displayed at the (at least one) monitor, to allow monitoring of movement of the catheter in the subject based on the x-ray image.

By contrast, in the Aldefeld et al. reference, only a scout x-ray image is obtained prior to the interventional procedure that uses a catheter. This image is also referred in the Aldefeld et al. reference as a "survey image" and in paragraph [0026] of the Aldefeld et al. reference, it is stated that the image dataset is *already* available during the intervention. This clearly means that the image is preoperative image that is obtained before the actual catheterization procedure takes place. In the next paragraph, this characteristic of the survey image is expressly contrasted with the image that is (or can be) obtained by optical coherence tomography. In that

paragraph [0027], it is stated that it must be possible to image the local anatomy in real time during an intervention, and it is for this possibility (i.e., generating an image in real time) that optical coherence tomography can be used. As noted above, this is directly contrasted with the survey image that is obtained by x-rays.

Therefore, it is clear that it never occurred to Aldefeld et al. to obtain an x-ray image *after* an OCT catheter is introduced into a subject, and to simultaneously display the x-ray image and the OCT image at (at least one) monitor, in order to permit monitoring of movement of the OCT catheter in the subject based on the x-ray image.

Moreover, even with the use of the real time imaging described in paragraphs [0027] through [0031] of Aldefeld et al., those real time images are still not used for monitoring, and instead a completely separate localization device 5 is used for that purpose, as described in paragraph [0020] of Aldefeld et al.

Therefore, the Aldefeld et al. reference does not disclose all of the elements of claim 1 as arranged and operating in that claim, and thus does not anticipate claim 1, or any of claims 2-3, 17 or 18 depending therefrom.

As to the obviousness rejection of claims 1-18 based on Aldefeld et al. and Hastings et al., Applicants submit that the Hastings et al. reference concerns only a method for magnetic manipulation of a medical device within the body of a patient in connection with magnetic resonance imaging, and does not provide any teachings of suggestions whatsoever with regard to x-ray image acquisition for any purpose, much less for the purpose of allowing monitoring of movement of an OCT catheter based on an x-ray image that has been obtained after the catheter has been introduced into the patient. The aforementioned statements concerning the Aldefeld

et al. reference are equally applicable to the modification of Aldefeld et al. in view of Hastings et al. proposed by the Examiner. For all of those reasons, Applicants submit that even if the Aldefeld et al. reference were modified in accordance with the teachings of Hastings et al., the subject matter of claim 1 still would not result, nor would the subject matter of any of claims 2-18.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519.

Submitted by

Steven H. Noll (Reg. 28,982)

SCHIFF, HARDIN LLP
CUSTOMER NO. 26574
Patent Department
6600 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
Telephone: 312/258-5790
Attorneys for Applicants.

CH1\ 4977340.1